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| EXAMINER | |
|---|---|
| JIMENEZ, MARC QUEMUEL | |
| ART UNIT | PAPER NUMBER |
| 3726 | |

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/764,974 | SCHASCHKE, HNAS-JURGEN | |
| | Examiner | Art Unit | |
| | Marc Jimenez | 3726 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *25 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *30-47* is/are pending in the application.

4a) Of the above claim(s) *30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *31-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Amendment*

1. Claim 30 should be indicated as - - (Withdrawn) - - instead of "(previously presented)" in the amendment filed 3/25/04.

### *Claim Objections*

2. **Claims 42 and 47** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 42 depends on claim 42 on page 4 of the amendment filed 3/25/04. Furthermore, there are two "claim 42" claims on page 4 of the response filed 3/25/04.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 31-33, 36, 42, 43, and 44** are rejected under 35 U.S.C. 102(b) as being anticipated by Hummel et al. (5,992,317).

Hummel et al. teach a method of using a roller **9 or 10** comprising a roller core and a roller covering being composed of an elastomer material or elastic plastic material (col. 3, lines 61-62, "the non-stick coating consists of a material which includes a fluorine-containing polymer"; see also claims 5 and 6, in col. 6, lines 7-13, which states "the non-stick coating on the surface of the at least one auxiliary roller contains a fluorine-containing polymer"; the "fluorine-containing polymer" of Hummel et al. is clearly an elastomer material or elastic plastic material) containing fluorinated polyolefin (col. 3, lines 63-64, "at least some proportion of polytetrafluoroethylene (PTFE)"; see also claims 7 and 8 of Hummel et al. at lines 14-19, which states "the non-stick coating on the surface of the at least one auxiliary roller contains polytetrafluoroethylene"; it is noted that PTFE or polytetrafluoroethylene is a fluorinated polyolefin as applicant claims in claim 33) comprising the step of running the roller **9 or 10** in a dampening system **4** (col. 4, line 1) of an offset printing machine (fig. 1 and col. 1, line 6-7).

Regarding claims 32 and 33, the PTFE taught by Hummel et al. is also a fluorocarbon plastic (see applicant's specification at page 5, lines 4-5 which states "..., the fluorinated polyolefin comprises fluorocarbon plastics, in particular fluorinated ethylene propylene copolymer (FEP) or polytetrafluoroethylene (PTFE)". Therefore, the PTFE of Hummel et al. is clearly a fluorocarbon plastic).

Regarding claim 36, Hummel et al. teach one layer and the elastic plastic material forms a surface layer.

Regarding claim 42, in as much structure claimed, the roller of Hummel et al. is considered a dampening roller.

Regarding claim 43, the roller **9,10** spreads a foundation solution **8**.

Regarding claim 44, the roller **9,10** spreads foundation solution continuously and with the same intensity over a plate cylinder **1** at all speeds via **11,5**. The claims do not require that the roller be in direct contact with the plate cylinder. In a similar fashion a person painting a wall spreads paint evenly via a paint roller. A persons hand does not physically touch the paint, but a person still paints the wall.

5. **Claim 45** is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hummel et al.

It is inherent that the core of Hummel et al. is made of metallic material because auxiliary rollers are typically made of metal. Alternatively, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have provided the invention of Hummel et al. with a metallic material core, in order to provide a rigid and long lasting roll.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. **Claims 34, 35 and 37-41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hummel et al. in view of Meltz (3,345,942).

Regarding claims 34, 35, and 37, Hummel et al. teach the invention cited, as explained

above in the rejection of claim 31, with the exception of having from 0.5 to 25% by weight of the fluorinated polyolefin, the fluorinated polyolefin being applied as a powder or fiber or in the form of a fibrous material, and the elastic plastic material is based on natural or synthetic rubber.

Meltz teach using from 0.5 to 25% by weight of fluorinated polyolefin (col. 1, lines 57-58) and the fluorinated polyolefin is applied as a powder (col. 3, lines 52-53 and col. 5, line 22). Meltz also teach that the fluorinated polyolefin could be mixed with a synthetic rubber (col. 3, lines 48-50).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Hummel et al. with from 0.5 to 25% by weight of the fluorinated polyolefin and the fluorinated polyolefin being applied as a powder, in light of the teachings of Meltz, in order to evenly spread the fluorinated polyolefin. Furthermore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have replaced the fluorine-containing polymer of Hummel et al. (see col. 3, lines 62-63 of Hummel et al.) with a synthetic rubber, in light of the teachings of Meltz, in order to provide a coating with evenly dispersed fluorinated polyolefin. It is noted that both Hummel et al. and Meltz recognizes the use of PTFE in the rollers.

Regarding claim 38, Meltz teaches that the synthetic rubber is selected from styrene-butadiene rubber (see col. 4, line 37).

Regarding claim 39, Meltz teaches that the elastomer or elastic plastic material is based on acrylonitrile butadiene rubber (col. 3, line 70).

Regarding claims 40 and 41, Hummel et al./Meltz teach the invention cited, in the rejection of claim 37 above, with the exception of the material being a thermoplastic elastomer or

a castable polyurethane system. It is noted however, that thermoplastic elastomer such as thermoplastic polyurethane and castable polyurethane systems are known materials (see for example the MatWeb.com and the Chemical Innovations document). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have substituted the materials of Meltz with either a thermoplastic elastomer or a castable polyurethane because thermoplastic elastomer and castable polyurethane are materials suitable for providing an elastic material. Furthermore, It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

8. **Claims 46 and 47** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hummel et al.

Hummel et al. teach the invention cited with the exception of the roller core being made of glass-fiber or carbon fiber reinforced plastic.

Official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have provided the invention of Hummel et al. with a glass-fiber or carbon fiber reinforced plastic core, in order to provide a rigid and long lasting roll.

***Response to Arguments***

9. Applicant's arguments filed 3/25/04 have been fully considered but they are not persuasive.

10. Applicant argues that while Hummel teaches a fluorinated polyolefin, Hummel do not teach an elastomer or elastic material containing fluorinated polyolefin. It is noted however, that in col. 3, lines 60-64, Hummel teaches "at least some **proportion** of polytetrafluoroethylene (PTFE)". Therefore, PTFE, which is considered a "fluorinated polyolefin" as claimed, is contained in a proportional amount in the coating. In col. 3, line 62, Hummel teaches that the coating includes a "fluorine-containing polymer" which is considered the claimed elastomer or elastic plastic material. In claim 5, col. 6, lines 8-9, Hummel teaches that the coating contains a fluorine-containing polymer. In claim 7 (which is dependent upon claim 5), col. 6, lines 15-16, Hummel teaches that the coating additionally contains polytetrafluoroethylene. Therefore, the PTFE added to the coating is added in a proportional amount to the coating material.

11. Applicant argues that Meltz does not teach the step of running the roller in a dampening system. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Hummel teaches running the roller in a dampening system.

12. Applicant argues that there is no proper motivation to combine Meltz with Hummel, however, Meltz has motivation in that the fluorinated polyolefin could be evenly spread in the roller layer.

13. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

14. Applicant argues that the rollers of Hummel are adjacent to form rollers, however, the claims do not preclude a form roller adjacent to the rollers.

15. Applicant argues that the rollers of Hummel do not meet the functional features discussed on page 10, lines 7-14 of the response filed 3/25/04. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., rollers were not able to receive and transfer the dampening medium and the feed of dampening medium form the fountain to the plate cylinder) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

16. Regarding the arguments with respect to new claims 43-44, see rejections above.

***Conclusion***

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Interviews After Final***

18. Applicant note that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the interview must be in writing) to clarify issues for appeal requiring only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations will be denied. See MPEP 714.13 and 713.09.

***Contact Information***

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is (703) 306-5965. The examiner can normally be reached on Monday-Friday between 5:30 a.m.-2:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marc Jimenez
Patent Examiner
AU 3726

**MJ**
June 14, 2004